IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application: Robert Newsteder	Art Unit: 2163
Serial Number: 09/989,202	Examiner: Uyen T. LE
Filed: November 21, 2001	Confirmation No: 9308
Title: DIRECTORY INFORMATION SYSTEM FOR PROVIDING TOLL-FREE NUMBERS	
Attorney Docket: 103177-41819	
Customer No: 26345	

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE AFTER FINAL ACTION

Sir:

In response to the final Office Action of December 6, 2004, the applicant requests withdrawal of the final Office Action on the basis that it fails to comply with MPEP 2143.03, which mandates that all claim language be considered before an obviousness rejection can be justified. It appears the Examiner opted to ignore the claim language following "may" or "allow" in the independent claims when rendering the obviousness claim rejection. The Examiner's rationale is apparently that claim language following the words "may" or "allow" in a claim may be disregarded in evaluating patentability, because such claim language is not construed to be a patentability requirement. That is, such a claim may be rendered obvious over prior art

even though such prior art lacks a counterpart to the claim language following "may" or "allow".

On such a basis, the Office Action rejected claims 1-22 under 35 U.S.C. 103(a) as being unpatentable over Kwak (US 2002/198933) in view of Hyodo (US 5,937,390). Such a rejection is traversed.

The final Office Action noted that the applicant argued that both Kwak and Hyodo lack a search capability for a user to "frame a search request for a toll-free telephone number or other company information based on information taken from advertising for a product or service". The final Office Action responded by contending that claims 1, 9, 17, 20 do not require the user to "frame a search request for a toll-free telephone number or other company information based on information taken from advertising for a product or service" Instead, they merely recite "may frame a search request for a toll-free telephone number or other company information based on information taken from advertising for a product or service". Thus, in view of the final Office Action, the claim language is broad enough to be interpreted by the examiner as in the previous Office Action.

The finding is traversed since it improperly ignores recited claim language, which is contrary to the mandate set forth in MPEP 2143.03. The presence of "may" or "allow" in a claim does not justify ignoring claim language following "may" or "allow" when rendering an obviousness rejection. MPEP 2143.03 provides:

2143.03 All Claim Limitations Must Be Taught or Suggested

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580

(CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under **35 U.S.C. 103**, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

INDEFINITE LIMITATIONS MUST BE CONSIDERED

A claim limitation which is considered indefinite cannot be disregarded. If a claim is subject to more than one interpretation, at least one of which would render the claim unpatentable over the prior art, the examiner should reject the claim as indefinite under **35 U.S.C. 112**, second paragraph (see **MPEP § 706.03(d)**) and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. Pat. App. & Inter. 1984) (Claims on appeal were rejected on indefiniteness grounds only; the rejection was reversed and the case remanded to the examiner for consideration of pertinent prior art.). Compare *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970) (if no reasonably definite meaning can be ascribed to certain claim language, the claim is indefinite, not obvious) and *In re Steele*, 305 F.2d 859,134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under **35 U.S.C. 103** on these assumptions).

LIMITATIONS WHICH DO NOT FIND SUPPORT IN THE ORIGINAL SPECIFICATION MUST BE CONSIDERED

When evaluating claims for obviousness under **35 U.S.C. 103**, all the limitations of the claims must be considered and given weight, including limitations which do not find support in the specification as originally filed (i.e., new matter). *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983) *aff'd mem.* 738 F.2d 453 (Fed. Cir. 1984) (Claim to a catalyst expressly excluded the presence of sulfur, halogen, uranium, and a combination of vanadium and phosphorous. Although the negative limitations excluding these elements did not appear in the specification as filed, it was error to disregard these limitations when determining whether the claimed invention would have been obvious in view of the prior art.).

Even if there was merit to the Examiner's decision to ignore the claim language "may frame a search request" in the penultimate clauses of independent claims 1 and 9, which there is not, doing so further requires ignoring the recitation of "the search request", which is found in the last claim clauses of claims 1 and 9 and which do not contain the verb "may" or "allow". Such a search request would be the framed search

request that the Examiner chooses to ignore. Thus, the Examiner is not only ignoring the recitation in the penultimate paragraph, but also in effect the last paragraph of claims 1 and 9. Otherwise, the Examiner would be compelled to deal with the cited prior art failing to reveal a framed search request as recited.

The same applies to independent claims 17 and 20, whose fourth clause uses the phrase "to allow a search request", which the Examiner chooses to ignore in considering patentability despite the recitation of "the search request" in subsequent claim clauses. Such disregard of structural recitations in determining patentability is without justification.

The previous arguments raised by the applicant in the Amendment filed in response to the claim rejection in first Office Action, which were not otherwise commented upon by the patent examiner, are repeated below for convenience.

Claims 1-22 are rejected under 35 USC § 103 as begin unpatentable over Kwak (US 2002/0198933), in view of Hyodo (US 5,937,390). According to the Office Action, it would have been obvious to one of ordinary skill in the art to combine the teachings of Kwak and Hyodo "in order to attract customers by providing a toll free number for customers to call". This rejection is traversed.

The patent to Kwak at paragraph [0037] advises about a website Lebx.com that allows advertising to list classified ads and listings. The patent to Hyodo reveals storing advertisements and toll free 800 numbers associated with the advertiser in an advertising information storage section 11 that a user may access. The examiner contends that modifying Kwak by Hyodo would be obvious to a person of ordinary skill in the art so as to attract customers by providing toll-free numbers for customers to call.

The end result would be that the classified ads and listings that are advertised (Kwak) would include storage of 800 toll-free numbers associated with the advertiser.

In contrast, the independent claims 1, 9, 17 and 20 each call for the ability "to frame a search request for a toll-free telephone number or other company information based on information taken from advertising for a product or service." Both Kwak and Hyodo lack such a search capability for a user. Paragraph [0027] of Kwak merely mentions that it enables pre-existing customers to list classified ads and auction listings of Labx.com. Nothing is mentioned about framing a search request based on information from advertising. Hyodo at col. 4 lines 11-37 discusses a seven step shopping procedure. Step 1 mentions that on-line advertising displays and explanation of products and a toll-free number, but nothing is mentioned about framing a search request based on information from advertising.

To assist the examiner in understanding the claimed invention, consider the following excerpt from page 4 lines 8-18 of the present application:

> Accordingly, the present invention provides an Internet-based directory information system for providing toll free telephone numbers and other information of companies, where the numbers are provided based primarily or solely on information from a television or radio advertisement for products or services from such companies. The present invention also provides a telephone-based directory information system for providing toll free telephone numbers and other information of companies, where the numbers are provided based primarily or solely on information from an advertisement for products or services from such companies.

The present invention also provides a method for providing the toll free telephone number and other information of a company via the Internet or telephone based on the air date, approximate air time, and airing station or other presentation information of an advertisement for goods or services from that company.

The main deficiency in locating a toll free number or any number for that matter with conventional techniques is that unless the exact name of the person or company in whose name the number is known, the search request for the number will be fruitless. The advertised numbers for goods and services may be that of "marketing" companies, as opposed to that of the parent company or individual retailing the goods or services.

Thus, a person calling toll free information at 1-800-555-1212 would not obtain a desired toll free number from the toll free information service unless the person provided the exact name of the listed entity with the toll free information service. If all the person remembered about the toll free number that had been advertised in a radio or television ad was the product or deal that have been offered, providing such information to the toll free information service would not help in the retrieval of the toll free number that had aired.

As far as the inventor is aware, search engines used on the Internet are not set up to correlate such toll free numbers with criteria other than the exact name of the listing with the toll free number information service. Indeed, such search engines are useful where constant, non-variable search criteria is used. Since the criteria is variable, as is the case for advertising toll free numbers for which advertisers are ever changing the choice of media, time, city, etc. to run the advertisement containing the toll

free number, such variable criteria needs to be updated constantly on a website to stay current for a search request to lead to meaningful results. In view of the need to provide a toll free number based on search criteria that did not include the name or address of toll free number owner listed with an information service that the present invention came about. Indeed, it is not even necessary in accordance with the invention for the identity of the name or address of the listed toll free number owner to be known to enable retrieval of the toll free number from framing a search request from advertising information.

The examiner is invited to explore www.calltollfree.com to get an idea of a sampling of what questions a visitor would answer that would give the desired results (although the website is not functioning to actually provide the results).

CORRESPONDENCE AND FEES:

In the event that there are fees necessitated by this response, authorization is hereby given to charge Deposit Account No. 03-3839. Please address all correspondence to Intellectual Property Docket Administrator, Gibbons, Del Deo, Dolan, Griffinger & Vecchione, One Riverfront Plaza, Newark, NJ 07102-5497. Should there be any questions or other matters that may be resolved by a telephone call, the Examiner is invited to contact the applicants' undersigned attorney at the number below. Any communications should be sent directly to him at the number below.

Application No. 09/989,202
Response Dated February 9, 2005
Reply to Office Action of December 6, 2004

Respectfully submitted,

Gibbons, Del Deo, Dolan, Griffinger & Vecchione

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